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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,724	03/25/2004	Ian B. McPherson	10813ABUS02C (NORT10-0038)	5638
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/808,724

Applicant(s)

MCPHERSON ET AL.

Examiner

RAJ JAIN

Art Unit

2416

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37, 38, 40-44, 46-53 and 55-57 is/are rejected.
- 7) ☒ Claim(s) 39, 45, 54 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No.(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No.(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 37-42, 43-48, 49-54, 55 and 56 is provisionally rejected on the ground of nonstatutory double patenting over claims 1-5, 6-10, 11-16 also 18-23 and 32 and 43 respectively against patented case 6,751,198.

This is a provisional double patenting rejection since the conflicting claims of the present applicant has not yet been patented. Both, the subject application and the patented case have claim languages that are phrased differently to claim the same subject matter, thus they are not patentably distinct from each other.

The subject matter claimed in the instant application is fully disclosed in the patented case referenced and would be covered by any patent granted on the instant application since the referenced patented case and the instant application are claiming common subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 38, 40-44, 46-53 and 55-57 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Andersson et al (USP 4,322,793).

Regarding claims 37, 43, 49, and 55 Andersson discloses a network device (Fig. 1, a communications controller with network devices) for use in a network transmitting packets the device comprising:

a timer (col 5 lines 60-col 6 line 60);

a processor operable for setting a transmit bit in an outgoing packet and starting the timer when the transmit bit is set (see Fig 1 and 2; col 13 lines 29-45; start/stop operations are performed based on transmit and receive bits within a byte); and for reading a receive bit in a received packet and stopping the timer when the receive bit is read (again see Fig 1 and 2; col 13 lines 29-45; stop bit in the received byte is read to stop the timer accordingly).

Regarding claims 38, 44, and 50 Andersson discloses an interface coupled to the processor, the interface operable for coupling the network device to the network and for transmitting the outgoing packet (Figs. 1, CCA interface is coupled to the processor 1).

Regarding claims 40, 46 and 57 While Andersson fails discloses a transmitting means for a voice packet, however since Andersson discloses a general communications controller integrated into a host CPU, it would have been obvious to incorporate the same within a voice transmission system to enhance voice packet transmission by reducing packet delay as appropriate.

Regarding claim 51 Andersson discloses interface is operable for receiving a second voice packet, and the processor is operable for checking the second voice packet to determine if a receive bit is set and stopping the timer if the receive bit is set

(again, see Fig 1 and 2; col 13 lines 29-45; stop bit in the received byte is read to stop the timer accordingly, for each successive packet or byte received having a stop bit).

Regarding claims 41, 47, and 52, Andresson discloses a round trip register operable for receiving a value from the timer (abstract, col 3 lines 14-28).

Regarding claims 42, 48, and 53, While Andresson explicitly fails to disclose comparing the value in the round trip data register to a predetermined value and sending an indication to a user when the value in the round trip data register is greater than the predetermined value. Examiner takes official notice that predetermined thresholds having specific values used to trigger an desired response is well known in the arts and one can easily adapt the desired functionality within its invention as appropriate.

Allowable Subject Matter

Claims 39, 45, 54 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 7/17/08 have been fully considered but they are not persuasive.

With regards to double patenting rejection, Examiner acknowledges that applicant is prepared to file a terminal disclaimer when this is the only rejection remaining in the claims. Examiner would like to point out that this rejection will remain part of this and future correspondence until it is resolved.

With regards to claims 37,38,40-44,46-53,55 and 57, Applicant contends Andersson et al (USP 4,322,793) fails to disclose " (1) setting a transmit bit in an outgoing packet and starting a timer when the transmit bit is set, or (2) reading a receive bit in a received packet and stopping the timer when the receive bit is read."

Examiner respectfully disagrees, an ICA (Fig. 1, ref 4) as a processor within diagnostic facility utilizes the ICA timer to control the CCA (col 31 lines 17-47). Inline testing initiates the ICA timer within a given timer interval to perform desired inline tests, which than updates a state counter and restarts the ICA timer. The Examiner asserts in

order for these steps to be performed a "bit" must be utilized to determine either a "start or stop" functionality of a timer within the processor, and thus the processor must be able to either write and/or read the bit in order to properly perform the above steps. The Examiner asserts that Andersson does disclose a start/stop bit timing capabilities within its invention and therefore believe the rejection of claims 37,38,40-44,46-53,55 and 57 to be proper and therefore the rejection of subject claims is sustained.

Conclusion

THIS ACTION IS MADE FINAL, and is intended to close prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **RAJ JAIN** whose telephone number is (571)272-3145. The examiner can normally be reached on **M-TH 6AM-4PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raj K. Jain/

Examiner - Art Unit 2616

October 16, 2008

/Chi H Pham/

Supervisory Patent Examiner, Art Unit 2416

10/10/08